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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,146	01/26/2001	George Coleman	06620/026001	6198

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EXAMINER	
MULCAHY, JOHN M	
ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Applicati n No.</b>	<b>Applicant(s)</b>
	09/771,146	COLEMAN ET AL <i>MT</i>
<b>Examiner</b>	<b>Art Unit</b>	
John M. Mulcahy	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 December 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,8-53,55,61-72,76-86,100,101,105-114 and 121-137 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,8-24,26-30,32-39,49,50,55,61-67,70,72,76,78-81,85,86,100,105-107 and 130-135 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Pri rity under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 25,31,40-48,51-53,68,69,71,77,82-84,101,108-114,121-129,136 and 137.

***Election/R strictions***

1. Applicant's election without traverse of Species A (Fig. 1A) in Paper No. 3 is acknowledged. Claims 25, 31, 40-48, 51-53, 68, 69, 71, 77, 82-84, 101, 108-114, 121-129, 136 and 137 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1, 8-10, 18-21, 27-29, 32-39, 49, 50, 55, 61-67, 70, 72, 76, 78-81, 85, 86, 100, 105-107, 130 and 132-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,700,236) and Eino et al. (4,869,237) in view of each other.

Eino et al. clearly teaches the subject matter of claims 1, 18-21, 27-29, 32-34, 37-39, 49, 50, 55, 63-67, 70, 72, 76, 78-81, 85, 86, 100, 105-107, 130, 132 and 133. See the entire document. Note sheath 7 and mirror 8. See especially Figures 3, 8 and

11 and their descriptions; col. 17, lines 26-30. However, Eino et al. fails to teach a plurality of sleeve assemblies having mirrors 8 of different angles.

Sauer et al. clearly shows the subject matter of claims 1, 8-10, 18, 21, 27-29, 35-39, 49, 50, 55, 61-66, 70, 72, 76, 78-81, 85, 86, 100, 105-107 and 134. See the entire document. Note mirror 25. See especially Figures 4, 17 and 22; col. 5, last line; and the last full paragraphs in columns 8, 11 and 12. However, Sauer et al. fails to teach mirrors of different fixed angles on the different sleeve assemblies. Rather, the mirrored surface 25 for the different sleeve assemblies would remain parallel to the longitudinal axis of the sleeve, with only the angle of the prism 24 varying between sleeves.

However, Eino et al. teaches an analogous endoscope in which an angled mirror 8 is used to equivalently change the angle of view on an analogous adapter 7. It would have been obvious to the artisan to modify Sauer et al. by employing an angled mirror to change the angle of view since Eino et al. teaches such to be equivalent to the prism of Sauer et al. for such purpose and such would save the expense of the prism. It would have been further obvious the artisan to modify Eino et al. by providing a plurality of sleeve assemblies having different angled mirrors since Sauer et al. suggests that such adjustability would be useful to the surgeon and it has been held that the provision of adjustability, where desirable, is an obvious modification. In re Stevens, 212 F.2d 197, 101 USPQ 284 (CCPA 1954).

b. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,700,236) in view of Eino et al. (4,869,237) as applied to claims 1 and 9 above, further in view of Karasawa et al. (5,575,756).

Sauer et al. fails to teach an O-ring or a cavity between the sleeve and endoscope. However, Karasawa et al shows such an arrangement. See Figs. 11-12 and their description. As to claim 13, see the projections 497 in the modification of Fig. 63. Inasmuch as Sauer et al. discloses a fluid conduit 78, it would have been obvious to the artisan to further modify Sauer et al. by using a cavity between the sheath and endoscope as the conduit as taught by Karasawa since Karasawa teaches that such would simplify assembly and cleaning. See col. 1, line 50 *et seq.*

c. Claims 22, 23, 26 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. in view of Sauer et al. (5,700,236) as applied to claims 18 and 130 above, further in view of Olympus Optical Co. (JP 10-262921) (Olympus).

Eino et al. fails to teach an image processor which rotates the image. However, Olympus teaches such a processor 34. As to claim 26, note text in Fig. 11. It would have been obvious to the artisan to further modify Eino et al. by providing such an image processor and text generator since Olympus suggests that such would reduce inspection time. See English language abstract. Note that the corrected and uncorrected images are displayed simultaneously (claim 23). See Fig. 8.

d. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. (4,869,237) in view of Sauer et al. (5,700,236) and Olympus (JP 10-262921) as applied to claim 23 above, further in view of Matsunaka et al. (5,305,098).

Eino et al. in view of Olympus fails to teach simultaneous display of images obtained at different times. However, Matsunaka et al. shows such an arrangement in an analogous endoscope. See Fig. 18 and its description. It would have been obvious

to the artisan to add such capability to Eino et al. since Matsunaka et al. teaches that such would facilitate diagnosis of disease.

e. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eino et al. (4,869,237) in view of Sauer et al. (5,700,236) as applied to claim 1 above, further in view of Sheldon (2,987,960).

Eino et al. fails to teach a rounded end. However, Sheldon shows an analogous side-viewing endoscope having a rounded end. It would have been obvious to the artisan to further modify Eino et al. by providing a rounded end since such would make insertion of the endoscope easier than with the blunt end illustrated in Eino et al.

f. Claim 135 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,700,236) in view of Eino et al. (4,869,237) as applied to claim 134 above, further in view of Yamamoto (6,063,024).

Sauer et al. fails to teach illuminating the image using the same optical path as is used for imaging. However, Yamamoto teaches such an arrangement in an analogous endoscope. It would have been obvious to the artisan to further modify Sauer et al. by illuminating the image using the same optical path as is used for imaging since Yamamoto teaches that such an arrangement is beneficial in that it allows the diameter of the insertion portion to be reduced.

### ***Response to Arguments***

3. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John M. Mulcahy  
February 24, 2003

John M. Mulcahy  
Primary Examiner  
Art Unit 3739